



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#29
6/20/03

Applicant: Mario Guillen)
Serial No.: 09/473,386) Group Art Unit: 1661
Filed: December 28, 1999) Examiner: J. Hwu
Title: Trailing Interspecific Impatiens)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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RESPONSE

Sir:

This Response is being submitted in connection with the Office Action dated January 28, 2003 in the above-identified application.

REMARKS

Reconsideration of the above-identified application in view of the foregoing amendments and following arguments is respectfully requested.

Claim Rejections – 35 U.S.C. Section 112

Claims 13-24 and 26-30 are rejected under 35 U.S.C. Section 112, first paragraph as not being described in the specification in such a way to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant respectfully traverse this rejection.

As discussed in the previous Response filed on December 16, 2002, the inquiry into whether the written description requirement is met is determined on a case-by-case basis and is a question of fact. *Manual of Patent Examining Procedure* Section 2163.04 (Eighth Edition, August 2001). A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. *Id.* The Examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. *Id.* The Examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *Id.*

Claim 13 is directed to an interspecific impatiens plant that comprises a trailing habit and is produced by crossing an *Impatiens flaccida* plant with an *Impatiens Hawkeri* plant. Claim 14 relates to pollen of the above-described plant. Claim 15 relates to an

ovule of said plant. Claim 16 relates to a tissue culture of regenerable cells from said plant. Claim 17 relates to asexually reproduced progeny of said plant. Claim 18 states that the asexually reproduced progeny of claim 17 is a cutting.

Claim 26 relates to a trailing interspecific impatiens plant produced by the process described in allowed claim 25. Claim 27 relates to pollen from a trailing interspecific impatiens plant produced by the process of claim 25. Claim 28 relates to an ovule from a trailing interspecific impatiens plant produced by the process of claim 25. Claim 29 relates to asexually reproduced progeny produced by the trailing interspecific impatiens plant produced by the process of claim 25. Claim 30 states that the asexually reproduced progeny of claim 29 is a cutting.

The specification on pages 1 and 3-6 describes novel impatiens plants having a trailing habit produced as a result of a unique interspecific cross between *Impatiens flaccida* and *Impatiens Hawkeri*. The specification provides examples of two impatiens plants, 2245B and 2257B, that were produced from this cross and have a trailing habit.

Applicant herewith encloses three photographs of impatiens plants produced by the unique interspecific cross of the claimed invention. These photographs are labeled Figures 1, 2 and 3 respectively. The plants were grown under standard greenhouse conditions at the PanAmerican Seed research and production facility located in Costa Rica. Figure 1 shows a photograph of a five (5) month old plant produced from the claimed interspecific cross that does not exhibit the trailing habit. In contrast, Figures 2 and 3 are photographs of eight (8) month old plants produced by the unique interspecific cross of the present invention that exhibit a trailing habit. As the Examiner can appreciate after examining these photographs, the difference between the plant shown in Figure 1 and the plants shown in Figures 2 and 3 is dramatic and is quite noticeable.

In further support of his position, Applicant encloses herewith is a Declaration by Dr. Scott Trees under 37 C.F.R. Section 1.132 (hereinafter referred to as "Declaration"). As discussed in Dr. Trees' Declaration, the level of skill possessed by ornamental plant breeders is high. As discussed in the Declaration, it would be routine for plant breeders such as Dr. Trees to select for plants exhibiting a trailing plant habit. In fact, it is Dr. Trees' opinion that any ornamental plant breeder using his/her routine skill and knowledge coupled with the description of the unique interspecific cross and the examples provided in the specification of the present application, would not have any difficulty in identifying plants having a trailing plant habit produced from the claimed unique interspecific cross as well as understand that such plants are contemplated within the scope of the present invention (See Declaration, Paragraph 9). Therefore, because the level of skill in plant breeding is high, Applicant submits that the two (2) examples of plants exhibiting a trailing plant habit produced by the unique interspecific cross described in the specification sufficiently demonstrates that the inventor had possession of the invention at the time the application was filed.

Thereupon, in view of the aforementioned Declaration and the above arguments, Applicant respectfully submits that the Examiner has not provided a reasonable basis for

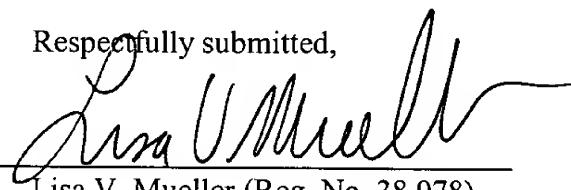
challenging the adequacy of the written description of the present application. Specifically, the Examiner has not met her burden of providing by a preponderance of the evidence why one of ordinary skill in the art would not recognize that the present disclosure a description of the invention as defined in the claims. Therefore, Applicant submits that this rejection should be withdrawn.

In view of the aforementioned amendments and arguments, Applicant submits that claims 13-24 and 26-30 are now in condition for allowance.

If any additional fees are incurred as a result of the filing of this paper, authorization is given to charge deposit account number 23-0785.

Respectfully submitted,

By:


Lisa V. Mueller (Reg. No. 38,978)
Attorney for Applicant

WOOD, PHILLIPS, KATZ, CLARK & MORTIMER
500 MADISON STREET
SUITE 3800
CHICAGO, IL 60661
(312)-876-1800

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CERTIFICATE OF MAILING

I hereby certify that this Amendment is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on a June 11, 2003.

